

**Remarks**

Currently claims 1-7 are undergoing substantive examination in the application. Claims 8-13 have been withdrawn. An amendment has been made to claim 2 to clarify the subject matter contained therein. An abstract of the invention has been added. Figure 1 has been amended. A submission of sequence listing and computer readable format, as well as amendments to the specification to insert appropriate SEQ ID NOS, have been made in compliance with 37 C.F.R. §§1.821-1.825. The amendments do not add any new matter within the meaning of 35 U.S.C. §132, therefore entry of the amendments is respectfully requested.

### **I. Sequence Rules**

The Examiner has indicated that in order to meet the requirements of 37 C.F.R. §§1.821-1.825 amendment to the specification is required at pages 21-23 to insert the appropriate sequence identifiers. Additionally, the Examiner has required that a sequence listing and computer readable format thereof be submitted.

As shown in the amendments above, Applicants have amended paragraphs [0098], [0101], [0107], [0108], [0111] – [0114], [0117] – [0119], and [0121] – [0123] of the instant application as referenced in U.S. Published Patent Application No. 20050250101 A1 to include SEQ ID NOS.

Furthermore, Applicants submit herewith a sequence listing and a computer readable format thereof, as well as a Sequence Listing Submission Statement.

Therefore, Applicants have complied with the sequence rules as put forth in 37 C.F.R. §§1.821-1.825.

### **II. Specification**

The Examiner has stated that the instant application does not contain an abstract of the invention.

Applicants have attached an abstract of the invention hereto, thereby removing the basis for this objection. Therefore, Applicants have complied with the requirements of 37 C.F.R. § 1.72(b).

**III. Rejection Under 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claim 2 as failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner alleges that “characterized in that said marker is added to materials selected from the group consisting of...paint” is vague and indefinite, since it is unclear whether claim 2 is drawn to a process or a product.

Applicants traverse this rejection and submit that this amendment clarifies that claim 2 particularly points out and distinctly claims a product.

Applicants respectfully submit that claim 2 has been amended to read:

The vehicle identifying marker according to claim 1, characterized in that said marker is **used with** materials selected from the group consisting of vehicle painting dye, vehicle coating solution, lacquer and coating paint.

As such, Applicants submit that claim 2 particularly points out and distinctly claims a product thereby removing the basis for this rejection. Therefore, the Examiner is respectfully requested to withdraw this rejection.

**IV. Rejection Under 35 U.S.C. § 102(b) Based on U.S. Patent No. 5,451,505**

The Examiner has rejected claims 1-7 as being anticipated by U.S. Patent No. 5,451,505 to Dollinger et al. ("Dollinger"). The Examiner alleges that Dollinger teaches a taggant which comprises a nucleic acid that has a specific nucleotide sequence that provides a means to store information, which can be added to substances including automobiles and automobile parts. The Examiner asserts that Dollinger teaches that the taggants may be covalently bonded to solid supports such as latex beads, dextran or magnetic beads or encapsulated by polymeric substances or lipophilic compositions.

Applicants traverse this rejection and respectfully submit the instant claims are patentably distinguishable from the teachings of Dollinger. Specifically, the taggant covalently bound to a solid support as taught by Dollinger may cause modification of oligonucleotide bases during extraction and recovery of oligonucleotides. This in turn harms amplification with the exact sequence. *See*, paragraph [0009] in application in U.S. Publication Patent Application No. 20050250101 A1.

Furthermore, the taggant encapsulated by polymeric proteins, such as proteins, or lipophilic compositions, such as liposomes, are totally different from the structure of oligonucleotide-PTA (phase transfer agent) of the presently claimed subject matter. In the case of liposomes, it is clear that the organic solvents of the instant subject matter could not be utilized due to the electrical repulsion between the hydrophobic portion of the liposome and the nonpolar solvent.

As such and on these bases, Applicants respectfully submit the instant claims are patentably distinguishable from the teaching of Dollinger. Therefore, the Examiner is respectfully requested to withdraw this rejection.

**V. Rejection Under 35 U.S.C. § 102(b) Based on International Publication No. WO 87/06383**

The Examiner has rejected claims 1 and 5-6 as being anticipated by International Publication No. WO 87/06383 to Le Page et al. ("Le Page"). The Examiner alleges that Le Page teaches an article labeled with a tag to which a signal compound is attached. The signal compound may further be attached to an adhesive or paper. The Examiner further asserts that Le Page teaches that the tag and signal compounds are nucleic acids and that the substance comprising the tag and signal can be used on any substance including car parts.

Applicants traverse this rejection and respectfully submit the instant claims are patentably distinguishable from the teachings of Le Page and that the reference does not teach each and every element of the instant claims. Specifically, the paper or adhesive of Le Page are different from the PTA according to the instant claims.

As such and on this basis, Applicants respectfully submit the instant claims are patentably distinguishable from the teachings of Le Page, since Le Page does not teach each and every element of the instant claims. Therefore, the Examiner is respectfully requested to withdraw this rejection.

**VI. Rejection Under 35 U.S.C. § 103(a) Based on U.S. Patent No. 5,451,505**

The Examiner has rejected claim 2 as being unpatentable over Dollinger, above. The Examiner alleges that Dollinger teaches a taggant which comprises a nucleic acid that has a specific nucleotide sequence that provides a means to store information, which can be added to substances including automobiles and automobile parts. The Examiner asserts that Dollinger teaches that the taggants may be covalently bonded to solid supports such as latex beads, dextran or magnetic beads or encapsulated by polymeric substances or lipophilic compositions. The Examiner further alleges that one of skill in the art would be motivated to arrive at the instantly claimed subject matter since Dollinger teaches taggants in automobile parts and paint products. The Examiner states in such case there would be a reasonable expectation of success.

Applicants traverse this rejection and respectfully submit the instant claims are patentably distinct from the teachings of Dollinger, and the Examiner has failed to make a proper *prima facie* case of obviousness. The Examiner has failed to articulate an adequate rationale for the reasonable expectation of success of the ordinary artisan.

Specifically, as discussed above, the taggant covalently bound to a solid support as taught by Dollinger may cause modification of oligonucleotide bases during extraction and recovery of oligonucleotides. This in turn harms amplification with the exact sequence. *See*, paragraph [0009] in application in U.S. Publication Patent Application No. 20050250101 A1.

The Examiner vaguely states that the ordinary artisan would refer to a ten year old reference and thus be motivated to include the vehicle painting dye and vehicle coating dye in both automobile parts and paint products which can contain taggants. However, the Examiner has not addressed this deficiency of Dollinger identified above, i.e. that when the taggant is covalently bound to a solid support modification of the oligonucleotide bases can occur during extraction and recovery of the oligonucleotides. The Examiner has failed to state why one of skill in the art would find such a

potential acceptable and therefore would have a reasonable expectation of success at arriving at the instantly claimed subject matter given the teachings of Dollinger.

On these bases, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner withdraw this rejection.

**VII. Rejection Under 35 U.S.C. § 103(a) Based on International Publication No. WO 87/06383**

The Examiner has rejected claim 2 as being obvious over Le Page, above. The Examiner alleges that Le Page teaches an article labeled with a tag to which a signal compound is attached. The signal compound may further be attached to an adhesive or paper. The Examiner further asserts that Le Page teaches that the tag and signal compounds are nucleic acids and that the substance comprising the tag and signal can be used on any substance including car parts. The Examiner has further alleged that it would have been *prima facie* for the ordinary artisan to include vehicle painting dye and vehicle coating dye in the composition taught by Le Page since Le Page teaches that signal compounds can be added to any substance, including art work and car parts. Likewise, the Examiner states that the ordinary artisan would have been motivated to be included in vehicle painting dye and vehicle coating dye since Le Page teaches signal compounds can be added to any substances and this would result in a reasonable expectation of success.

Applicants traverse this rejection and respectfully submit the instant claims are patentably distinguishable from the teachings of Le Page, and the Examiner has failed to make a proper *prima facie* case of obviousness. The Examiner has failed to articulate an adequate rationale for the reasonable expectation of success of the ordinary artisan.

Specifically, as discussed above, the paper or adhesive of Le Page are different from the PTA according to the instant claims. The Examiner refers to a reference published twenty-one years ago and again vaguely states that the artisan of ordinary skill would somehow be motivated by its

teachings and would have a reasonable expectation of success in light thereof to arrive at the instant subject matter through minor modification. However, Applicants submit that one of ordinary skill would not think that paper or adhesive is similar to the PTA of the instant subject matter, which neutralizes negative charges of oligonucleotides.

The Examiner has failed to state why one of skill in the art would find such a shortcoming of the reference acceptable therefore would have a reasonable expectation of success at arriving at the instantly claimed subject matter given the teachings of Le Page.

On these bases, the Examiner has failed to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner withdraw this rejection.



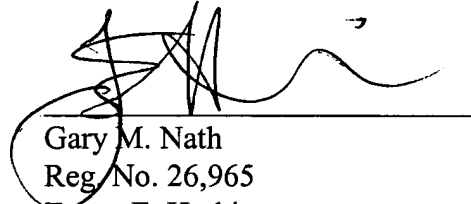
**Conclusion**

In view of the foregoing, Applicants submit that the application is in condition for immediate allowance. Early notice to that effect is earnestly solicited. The Examiner is invited to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

**THE NATH LAW GROUP**

A handwritten signature in black ink, appearing to read 'Gary M. Nath', is written over a horizontal line. The signature is stylized with a large loop at the beginning and a wavy end.

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